

100. (Amended) A computer program product, comprising:

a. a memory medium; and

b. a computer program stored on said memory medium, said computer program containing instructions for capturing prescription information using a computer interface of a personal digital assistant, for formatting said prescription information for communications; and sending said prescription formation to an offsite pharmacy over a communication link to be filled.

102. (Amended) A computer program product, comprising:

a. a memory medium; and

b. a computer program stored on said memory medium, said computer program containing instructions for implementing a graphical user interface permitting capture of prescription information and providing access to [one or more] all of (1) information about a patient's medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity, wherein the information is obtained from one or more offsite databases.

#### **REMARKS**

Reconsideration and allowance of the above-referenced application are respectfully requested. Claims 70, 72-92 and 94-102 are pending in this application. Claims 70, 72-92 and 94-102 are rejected. Claims 70, 85, 94-100, and 102 are amended.

The Examiner maintains that a substitute specification is required pursuant to 37 C.F.R. §1.125(a). Applicant requests that the Examiner reconsider his position for the reasons set forth in the attached Petition to the Group Director Under 37 C.F.R. §1.181.

Claims 70, 72-83, 85-92 and 94-102 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schrier et al. (U.S. Patent Number 5,833,599) in view of Cummings, Jr. (U.S. Patent Number 5,301,105). This rejection is respectfully traversed.

Schrier et al. is directed to a system and method for providing patient-specific drug information. Specifically, Schrier et al. is directed to a limited system which provides information about an “index” drug which is the drug selected by the user to treat the patient. Once the index drug is chosen, the system will provide additional information such as cost, dosage, an alternate drug, possible drug interactions, etc.

Cummings, Jr. is cited for teaching a system for “all care health management.” Specifically, Cummings, Jr. is directed to an integrated interconnection and interaction of the patient, health care provider, bank or other financial institution, insurance company, utilization reviewer and employer. Such a system ensures that the care the patient receives is approved by the insurance company and is paid for.

Claim 70 is directed to “A computerized prescription system, comprising ... a graphical user interface permitting capture of prescription information and providing access to all of (1) information about a patient’s prescription history, (2) information about pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating, and (3) information about the properties of pharmaceuticals...” (emphasis added). Using the graphical user interface to capture the prescription information allows the information to be displayed and provides access to “(1) information about the patient’s prescription history” via Rx History button 54, (2) information about pharmaceuticals arranged by medical conditions for the pharmaceuticals are suitable for treating via Condition button 86, and (3) information about the properties of pharmaceuticals via button 60 as shown in Figure 3. The graphical user interface as

claimed in claim 70 allows the user to capture and access the information in an efficient manner.

Neither Schrier et al. nor Cummings, Jr. disclose or suggest a graphical user interface permitting capture of prescription information and providing access to all of (1) information about a patient's prescription history, (2) information about pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating, and (3) information about the properties of pharmaceuticals..." as required by claim 70.

Moreover, the Examiner fails to cite where "(2) information about pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating" is disclosed or suggested by the cited art. Hence, the cited references fail to disclose or suggest each and every element as claimed in claim 70.

Moreover, it is well settled that the problem that is addressed and solved by a claimed invention must be given consideration in resolving the ultimate legal question of obviousness under 35 U.S.C. § 103. **North American Vaccine, Inc. v. American Cyanamid Co.**, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993). **Northern Telecom, Inc. v. Datapoint Corp.**, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). **In re Newell**, 51 F.3d 1552, 34 USPQ2d 1410 (Fed. Cir. 1995).

The claimed invention is directed to providing a computerized, prescription management system that an average prescribing physician can use and will want to use and which makes possible significant improvements in the quality of prescriptions written. (Page10, lines 7-11). The prescription management system of claim 70 makes possible significant improvements in the quality of prescriptions written by providing "a graphical user interface for capturing and providing access to (1) information about a patient's prescription history, (2) information about

pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating, and (3) information about the properties of pharmaceuticals...”

Schrier et al. is directed to a computer system which provides patient-specific drug information. Specifically, the computer system provides information relating to a specific drug selected by the user of the system. Cummings, Jr. is directed to a fully integrated and comprehensive health care system which integrates the physicians, medical care facilities, patients, insurance companies, and/or other health care payers, employers and banks and/or other financial institutions. Specifically, the health care system is directed to reducing costs, ensuring that treatments are approved via a utilization reviewer and that treatment is paid for. Therefore, the cited references are directed to solving different problems.

Hence, neither Schrier et al. nor Cummings, Jr. is directed to a computerized, prescription management system that an average prescribing physician can use and will want to use and which makes possible significant improvements in the quality of prescriptions written by providing a graphical user interface which provides the user “(1) information about a patient’s prescription history, (2) information about pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating, and (3) information about the properties of pharmaceuticals ...”

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is **some teaching, suggestion, or motivation to do** so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also MPEP 2143.01. It should be recognized that the fact that the prior art could be modified so as to result

in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Recognizing, after the fact, that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 f.2d 1011, 154, USPQ 173 (CCPA 1967).

Schrier et al. is directed to a closed system, i.e., a computer system which is limited as to where and what the computer system can access. For example, Schrier et al. only discloses sending a prescription to a pharmacy in the institution. (See Col. 13, lines 38-52). The computer system is limited to a local area network (LAN) which prevents accessing patient information from sources external to the LAN.

Cummings, Jr., on the other hand, is directed to a complete care health management system which includes connections to an insurance company and a bank or other financial system. Cummings, Jr. is directed towards an insurance system which ensures that the patient's expenses are covered under the scope of the insurance plan as well as financially.

Therefore, since both Schrier et al. and Cummings, Jr. are directed to two different types of systems, a closed LAN system and an open complete system, respectively, there is no reason why one skilled in the art would look to combine the two cited references.

For these and other reasons, claim 70, as well as dependent claims 72-84 and 98 are patentable over the cited art.

Since the Examiner cites the same reasoning in rejecting claim 99, claim 99 is patentable for the same reasoning as stated for claim 70.

Claim 85 is directed to “a method of creating a prescription ... capturing prescription information using a computer interface of a personal digital assistant.” Claim 84 also claims the use of personal digital assistant (PDA). For claim 84, the Examiner cites Ballantyne et al. for disclosing the use of a personal digital assistant. However, Ballantyne et al. does not use the PDA in the same manner as claimed in claims 84 and 85. Specifically, the PDA in Ballantyne et al. does not capture prescription information using a computer interface. Hence, the combination of references fail to disclose each and every element as claimed in claims 84 and 85.

For these and other reasons, claims 84 and 85, as well as dependent claims 86-90, are patentable over the cited art.

Regarding claim 100, the Examiner rejects claim 100 for the same reasons cited for claim 85, therefore claim 100 is patentable for the same reasons.

Regarding claims 91 and 101, the Examiner cites Schrier et al. as teaching “assembling patient information into a chronological current version of said patient’s medical history” as required by claims 91 and 101. However, the cited section, col. 6, lines 4-11, fails to teach or disclose assembling patient information into a chronological order. Hence, the cited art fails to teach each and every element as claimed in claims 91 and 101.

For these and other reasons, claims 91 and 101, as well as dependent claim 92, are patentable over the cited art.

Regarding claims 94 and 102, the Examiner cites Schrier et al. as teaching “a graphical user interface permitting capture of prescription information and providing access to one or more of (1) information about a patient’s medical history, (2) information about therapeutic agents and

(3) information about individual prescriber activity.” However, Schrier et al. does not disclose or suggest a graphical user interface permitting capture of prescription information and providing access to the information.

For these and other reasons claims 94 and 102, as well as dependent claims 95-98, are patentable over the cited art. Claim 70 is patentable for the same reasons cited for claims 94 and 102.

Regarding the rejections of claims 79, 88, 92, and 97, these rejections are respectfully traversed. The Examiner maintains the taking of Official Action with respect to claims 79, 88, 92, and 97. The Applicant again requests that the Examiner provide a reference for each of the elements that the Examiner labels as being old and well known in the medical arts. The Examiner is directed to section 2144.03 of the MPEP which states “If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.”

Regarding claim 79, the Examiner has taken Official Notice that it is old and well known in the medical arts to categorize pharmaceuticals by “body system.” Since one novel aspect of claim 79 is arranging information about pharmaceuticals by the body system, the Examiner is attempting to “fill the gaps” by improperly taking Official Notice. Applicant disputes the Examiner’s assertion as to what one of ordinary skill in the art would classify as old and well known in the art. Hence, there is a genuine dispute as to what the Examiner asserts as being old and well known in the art and is requested to provide a reference teaching categorizing pharmaceuticals by “body system.”

Regarding claim 88, the Examiner has taken Official Notice that it is old and well known in the medical arts to list pharmaceuticals in order of frequency of prescription for a specified condition. Since one novel aspect of claim 88 is listing pharmaceuticals in order of frequency of

prescription for a specified condition, the Examiner is attempting to “fill the gaps” by improperly taking Official Notice. Arranging the pharmaceuticals in such a manner can be extremely useful to a practitioner treating conditions which are new or uncommon to the user. Applicant disputes the Examiner’s assertion as to what one of ordinary skill in the art would classify as old and well known in the art. Hence, there is a genuine dispute as to what the Examiner asserts as being old and well known in the art and is requested to provide a reference teaching listing pharmaceuticals in such a manner.

Regarding claim 92, the Examiner has taken Official Notice that it is old and well known in the medical arts to discard “said current version of said patient’s medical history without creating a file copy.” Since one novel aspect of claim 88 is discarding the patient’s medical history without creating a file copy, the Examiner is attempting to “fill the gaps” by improperly taking Official Notice. Since patient privacy is a major concern to the patient in today’s society, discarding the patient’s history is extremely valuable in such a system. Applicant disputes the Examiner’s assertion as to what one of ordinary skill in the art would classify as old and well known in the art. Hence, there is a genuine dispute as to what the Examiner asserts as being old and well known in the art and is requested to provide a reference teaching the discarding of the medical history without creating a file copy.

Regarding claim 97, the Examiner has taken Official Notice that it is old and well known to include prescriber contact information. Since one novel aspect of claim 79 is including identification of how to contact the person who prescribed the one or more prescriptions, the Examiner is attempting to “fill the gaps” by improperly taking Official Notice. Applicant disputes the Examiner’s assertion as to what one of ordinary skill in the art would classify as old and well known in the art. Hence, there is a genuine dispute as to what the Examiner asserts as



being old and well known in the art and is requested to provide a reference teaching identification of how to contact the person who prescribed the one or more prescriptions.

Moreover, since claims 79, 88, 92, and 97 are dependent claims, these claims are all patentable for the same reasons cited for the independent claims they are dependent on. Moreover, the Examiner fails to cite any motivation why Schrier et al. should be modified to include the limitations the Examiner cites as being old and well-known in the medical field. Therefore, the Examiner has failed to meet a prima facie case of obviousness and as a result, the Examiner should reconsider and withdraw the 35 U.S.C. § 103 rejection of claims 79, 88, 92, and 97.

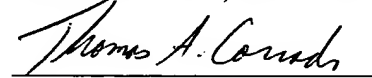
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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